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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,154	02/13/2006	Mitsuo Kimura	JFE-06-1012	5904
35811 7590 12/23/2008 IP GROUP OF DLA PIPER US LLP ONE LIBERTY PLACE 1650 MARKET ST, SUITE 4900 PHILADELPHIA, PA 19103			EXAMINER FOGARTY, CAITLIN ANNE	
			ART UNIT 1793	PAPER NUMBER
			MAIL DATE 12/23/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/568,154	KIMURA ET AL.	
	Examiner	Art Unit	
	CAITLIN FOGARTY	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 7, 2008 has been entered.

Status of Claims

2. Claims 24 – 34 are pending where claim 24 has been amended. Claims 1 – 23 and 35 have been cancelled.

Status of Previous Rejections

3. The 35 U.S.C. 103(a) rejection of claims 24 - 35 as being unpatentable over Kushida et al. (US 6,379,821) in view of the *ASM Handbook* has been withdrawn in view of the amendment filed October 15, 2008.

The nonstatutory obviousness-type double patenting rejection of claims 24 - 35 as being unpatentable over claims 25, 27-29, 31, and 34-36 of copending Application No. 10/576,885 has been maintained.

Claim Objections

4. Claim 1 is objected to because of the following informalities: the values of equations (1) and (2) are not clear due to a typographical error of omitting a value sign. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 1 recites the limitation "the texture further contains..." in line 20. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 24 – 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over the English machine translation of JP 2002-004009 (hereafter JP '009) from the IDS.

With respect to instant claim 24, [0001], [0010], and [0027] of JP '009 disclose a high strength stainless steel seamless pipe for use in oil wells with an outstanding corrosion resistance with an overlapping composition as shown in the table below.

Element	Instant Claim 24 (mass %)	JP '009 (mass %)	Overlapping Range (mass %)
C	0.005 – 0.05	≤ 0.05	0.005 – 0.05
Si	0.05 – 0.5	≤ 0.50	0.05 – 0.5
Mn	0.2 – 1.8	0.30 – 1.50	0.30 – 1.50
P	≤ 0.03	≤ 0.03	≤ 0.03
S	≤ 0.005	≤ 0.005	≤ 0.005
Cr	15.5 – 18	11.0 – 17.0	15.5 – 17.0
Ni	1.5 – 5	2.0 – 7.0	2.0 – 5
Mo	1 – 3.5	≤ 3.0	1 – 3.0
V	0.02 – 0.2	≤ 0.20	0.02 – 0.20

N	0.01 – 0.15	≤ 0.15	0.01 – 0.15
O	≤ 0.006	≤ 0.005	≤ 0.005
Fe + impurities	Balance	Balance	Balance

JP '009 also teaches that the seamless steel pipe has 10% or less retained austenite and a yield strength of 860 MPa or more which overlap with the corresponding ranges recited in instant claim 24.

JP '009 differs from instant claim 24 because it does not specifically teach equations (1) and (2). However, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those ordinary skilled in the art. *In re Austin, et al.*, 149 USPQ 685, 688.

In regards to instant claim 25, [0010] of JP '009 teaches that the stainless steel may also contain 0-0.05 mass% Al which overlaps with the range of Al recited in the instant claim.

Instant claims 26 – 28 further limit the compositions of C, Cr, and Mo. However, the stainless steel composition taught by JP '009 still overlaps with the ranges of C, Cr, and Mo recited in instant claims 26 – 28.

Regarding instant claims 29 and 30, [0010] of JP '009 discloses that the stainless steel may also contain 0 – 3.5 mass% Cu which overlaps with the ranges of Cu recited in the instant claims.

With respect to instant claim 31, [0010] of JP '009 teaches that the stainless steel may also contain ≤ 0.20 mass% Nb, ≤ 0.3 mass% Ti, ≤ 0.2 mass% Zr, ≤ 3.0 mass% W, and ≤ 0.01 mass% B which all overlap with the compositions of Nb, Ti, Zr, W, and B recited in the instant claim.

In regards to instant claim 32, [0010] of JP '009 discloses that the stainless steel may also contain 0.0005-0.01 mass% Ca which overlaps with the range recited in the instant claim.

Since the claimed compositional ranges of claims 24 – 32 either overlap or are within the ranges disclosed by JP '009, a prima facie case of obviousness exists. See MPEP 2144.05. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed stainless steel seamless pipe composition from the stainless steel seamless pipe composition disclosed by JP '009 because JP '009 teaches the same utility (i.e. use in oil wells) in the whole disclosed range.

Regarding instant claims 33 and 34, [0010] of JP '009 teaches that the primary phase of the stainless steel seamless pipe is martensite. JP '009 differs from instant claims 33 and 34 because it does not specifically teach the recited ferrite phase volume fractions. However, [0031] of JP '009 teaches that a diffraction intensity from (211) of alpha is present. Therefore, ferrite phase is present in the stainless steel seamless pipe. Since the composition of the stainless steel pipe is similar to the composition of the instant invention and since the pipe is made using a similar method, one of ordinary skill in the art would expect the stainless steel seamless pipe of JP '009 to have a similar volume fraction of ferrite phase. See MPEP 2112.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 24 – 34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 25, 27-29, 31, 35, 36, and 49 of copending Application No. 10/576,885. Although the conflicting claims are not identical, they are not patentably distinct from each other because the composition and microstructure of the high strength stainless steel seamless pipe recited in 10/576,885 overlaps in scope with the composition and microstructure of the stainless steel seamless pipe recited in claims 24 - 34 of the instant application. Also, the values of equations (1) and (2) of the instant application overlap with the values of equations (1) and (2) recited in 10/576,885. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed stainless steel pipe alloy composition from the stainless steel pipe alloy composition

disclosed by 10/576,885 because 10/576,885 teaches the same utility (i.e. pipes to hold oil) in the whole disclosed range.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

12. Applicant's arguments with respect to claims 24 – 34 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 2003/0127162 A1 discloses a high strength stainless steel seamless pipe for use in oil wells with a composition that overlaps with the composition recited in the instant claims.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CAITLIN FOGARTY whose telephone number is (571)270-3589. The examiner can normally be reached on Monday - Friday 8:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 1793

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/
Supervisory Patent Examiner, Art
Unit 1793

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